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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,482	12/12/2005	Frans Eduard Janssens	PRD2077f-PCT-USA	3160

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EXAMINER	
BAEK, BONG-SOOK	
ART UNIT	PAPER NUMBER
4161	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,482	JANSSENS ET AL.	
	Examiner	Art Unit	
	BONG-SOOK BAEK	4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/18/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Status of the Claims

Claims 1-20 are currently pending and are the subject of restriction and/or election requirement.

Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-14, drawn to a composition comprising an opioid analgesic, a 1-(1, 2-disubstituted piperidinyl)-4-substituted piperazine derivative, and a pharmaceutically acceptable carrier.

Group II, claims 15-20, drawn to method of using the composition.

It is noted claims 15-20 are use claims, which are non-statutory. Herein, claims 15-20 have been interpreted as method claims. Applicant is advised in response to the restriction to amend the use claims of 15-20 to be in standard US claim practice, or to cancel said claims.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons: the instant claim 1 lacks an inventive step over US patent 5,880,132 in the light of US patent 6,197,772 B1. US patent 5,880,132 teaches a composition comprising a tachykinin antagonist, an opoid analgesic, and a pharmaceutically acceptable carrier for the treatment or prevention of pain or nociception (abstract; column 1, lines 7-10; column 2, lines 33-36claim 4). The reference does not teach 1-(1, 2-disubstituted piperidinyl)-4-substituted piperazine derivatives recited in claim 1. However, US patent 6,197,772 B1 teaches the same generic chemical structure according to formula (I) and preferable embodiments for 1-(1, 2-disubstituted piperidinyl)-4-substituted piperazine derivatives recited in claim 1 (column 1, line 44-column 4, line 23; column 7, line 39-column 8, line 5; claims 1-3). In addition, US patent 6,197,772 B1 teaches that 1-(1, 2-disubstituted piperidinyl)-4-substituted piperazine derivatives have tachykinin antagonistic activity (column 1, lines 9-14). A person of ordinary skill in the art at the time of the invention was made would have been motivated to combine a 1-(1, 2-disubstituted piperidinyl)-4-substituted piperazine derivative with an opioid analgesic for the treatment and/or prevention of pain and/or nociception. Therefore, the instant claim 1 does not share technical feature with the instant method claims 15-20 and as such, unity between the above Groups I and II is broken.

Species Elections

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

If applicant selects Group I, one specific species from generic chemical structure of the Formula (I) set forth in claim 1 should be chosen to be fully responsive.

The species listed above do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because they are distinct chemicals which have different chemical or pharmaceutical properties and requires different methods of making. In addition, US patent 6,197,772 B1 teaches species set forth in claim 1 (abstract; claim 1; column 1, line 44-column 4, line 23; and column 7, line 39-column 8, line 5).

If applicant selects Group I, one species from different opioid analgesics should be chosen to be fully responsive. The following is a list of different opioid analgesics as set forth in claims 12-13: alfentanil, buprenorphine, butorphanol, carfentanyl, codeine, diacetylmorphine, dihydrocodeine, fentanyl, hydrocodone, hydromorphone, levorphanol, lofentanyl, meperidine, methadone, morphine, nalbuphine, oxycodone, oxymorphone, pentazocine, propoxyphene, remifentanyl and sufentanyl; and derivatives and pharmaceutical acceptable salts thereof.

The species listed above do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because they are distinct compounds which have different physiological or pharmaceutical properties and different affinities for opioid receptors. In addition, US patent 5,880,132 teaches species set forth in claim 12-13 (column 26, lines 23-48).

If applicant selects Group II, one species from different types of pain and side effects associated with opioid analgesic usage should be chosen to be fully responsive. The following is a list of different types of pain and side effects associated with opioid analgesic usage as set forth in claims 15-20:

1) Pain and/or nociception (acute and chronic pain-inflammatory, post-operative, emergency room (ER), breakthrough, neuropathic and cancer pain)

2) Emesis in opioid-based treatment of pain

3) Nausea and vomiting in opioid-based treatment of pain

4) Respiratory depression in opioid-based treatment of pain

5) Opioid-tolerance in opioid-based treatment of pain

The species listed above do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because they are distinct types of pain or symptoms which have different etiology and requires different medicaments. In addition, US patent 5,880,132 teaches species set forth in claim 15-20 (column 2, line 47-column 3, line 6).

The following claims are generic: claims 1, 11, and 14 for Group I and claim 15 for Group II.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.Any inquiry concerning this communication or earlier communications from the examiner should be directed to BONG-SOOK BAEK whose telephone number is 571-270-5863. The examiner can normally be reached on 8:00-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BONG-SOOK BAEK
Examiner, Art Unit 4161

Bbs

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4161